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| 09/893,547 | 06/29/2001 | Jonathan Sharp | 004770.00976 | 4444 |
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| CHANKONG, DOHM | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/893,547

Applicant(s)

SHARP ET AL.

Examiner

DOHM CHANKONG

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 30 and 32-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 30, and 32-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- 1> This action is in response to Applicant's amendment and arguments, filed 11.30.2007. Claims 22, 30, 33, 34 are amended. Claims 15-21, 23-29, and 31 are canceled. Claims 35-45 are added. Thus, claims 22, 30, and 32-45 are presented for further examination.
- 2> This is a final rejection.

Response to Arguments

- 3> Applicant argues that Peng is not entitled to earlier filing date of its provisional application because the provisional is "a collection of technical literature that bears little resemblance to the issued Peng patent." Applicant also argues that some reference must be made to the provisional application in making the rejection.

As Applicant correctly notes, Peng is entitled to the priority date of its provisional application "if the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. §112, first paragraph." MPEP §2136.03(III). Clearly, there is no affirmative requirement that the rejection make explicit reference to or rely upon the provisional application. The only requirement is that the provisional application support the subject matter of the patent that was relied upon to make the rejection.

To this end, the prior examiner directed Applicant to refer to a section in the provisional application that did support the subject matter. Final Rejection (9/18/2006), pg. 10, section 19. In addition to this previously cited section, Applicant is also directed to pages

70-71 of the provisional application which discusses updating applications that are just downloaded. This functionality is consistent with and supports the subject matter of the patent relied upon to teach adaptation data. If Applicant persists in asserting that Peng is not entitled to the earlier filing date, Applicant should explicitly refer to the subject matter in the Peng reference that is not supported by the provisional application.

Applicant also argues that Peng and Srinivasan fail to disclose computing remuneration data by computing the payment to be made to a content provider on the basis of the level of successful downloads from the server. Applicant argues that Srinivasan and Peng are unrelated and that Srinivasan does not disclose "monitoring."

First, the limitation does not claim any functionality related to "monitoring" so it is unclear why Srinivasan or any cited art would need to disclose a monitoring feature with respect to the remuneration feature. Seemingly, Applicant's arguments are directed to the limitation of "monitoring the downloading of said adaptation data." This limitation is unrelated to the remuneration limitation. In any case, as set forth in previous rejections, Peng teaches monitoring the downloads of the adaptation data [column 7 «lines 38-44»].

Second, the claimed limitation simply recites computing remuneration data based "on the level of successful downloads from the apparatus." Srinivasan discloses this claimed feature. Specifically, Srinivasan discloses that remuneration data (billing procedures) is calculated only upon a successful download [column 6 «lines 30-36»]. Billing procedures read on remuneration.

Third, it is unclear to what test Applicant is referring, but there is not requirement that Srinivasan and Peng must be "related" in order for one of ordinary skill in the art to

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have combined them. Srinivasan is directed to a method of charging users for downloads. Peng discloses downloading adaptation data to user devices. One of ordinary skill in the art would easily realize the possibility of incorporating Srinivasan's billing system into Peng's downloading system to create a system that charges users for downloading adaptation data.

Thus, based on the foregoing discussion, Applicant's arguments are not found persuasive. The rejection set forth in the previous action by the prior examiner is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 4> Claims 15-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peng (U.S. Patent Number 6,816,944) in view of Srinivasan (U.S. Patent Number 6,460,076).
- 5> Peng disclosed a system for providing personalized application and data management to mobile devices. In an analogous art, Srinivasan disclosed a system for downloading data files over a data network such that customers are billed based on successful acquisition of the data files.

6> Concerning claims 22, 33-35, 38, 41, 43, and 45, Peng did not explicitly state computing remuneration data by computing the payment to be made to a content provider on the basis of the level of successful downloads from the server. Peng does use a transaction manager in order to track the progress and status of each transaction. Peng also bills the user for certain transactions, but he is not explicit about how payment to be made is computed.

However, Srinivasan teaches billing customers based on the successful acquisition of data files by the customers. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Peng by adding the ability to compute the payment to be made to a content provider on the basis of the level of successful downloads from the server as provided by Srinivasan. Here the combination satisfies the need for an automated billing process for Charging customers who download information. See Srinivasan, column 1, line 64 through column 2, line 3. This rationale also applies to those dependent claims utilizing the same combination.

7> Concerning claims 40 and 41, Peng does not expressly disclose receiving a signal from an operator server that a download of adaptation data has been successfully received. However, such a feature was well known in the art at the time of Applicant's invention. For example, Srinivasan discloses sending an acknowledgement that download of data is complete [column 6 «lines 27-32»]. It would have been obvious to one of ordinary skill in the art to have modified Peng to include Srinivasan's acknowledgement functionality to properly signal that the user should be billed for the downloaded data.

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8> The following line citations refer to Peng unless otherwise noted. Thereby, the combination of Peng and Srinivasan discloses:

- «Claims 15, 18, and 22»

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising:

providing electronic content for storage on a memory of said portable radio communication device (column 5, lines 1-16; Column 7, lines 12-18; and column 8, lines 8-18 and 31-48);

providing adaptation data on a memory of said server (column 15, lines 3-26); allowing access to said adaptation data on said server for downloading from said memory of said server to said portable radio communication device (column 15, lines 3-26);

downloading said adaptation data from said memory of said server to said portable radio communication device (column 15, lines 3-26);

monitoring downloading of said adaptation data by said portable radio communication device from said memory of said server to provide output data (column 7, lines 38-44);

applying said adaptation data to said electronic content so as to modify said electronic content to provide adapted electronic content (column 15, lines 20-26);

generating data based on the output data of said monitoring downloading of said adaptation data (column 7, lines 38-44); and

computing remuneration data related to the electronic content and the adaptation data based on the generated data, the method including monitoring the volume of downloads that

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the server is performing and computing the payment to be made to a content provider on the basis of the level of Successful downloads from the server (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36).

- «Claims 16 and 19»

A method according to claim 15, wherein:

a content provider provides said electronic content for storage on the memory of said portable radio communication device (column 8, lines 8-18 and 31-48);

the content provider provides said adaptation data for storing on the memory of said server (column 15, lines 3-15);

a content enabler allows access to said adaptation data for downloading from said memory of said server to said portable radio communication device (column 15, lines 13-26); and

the content enabler provides for monitoring downloading of said adaptation data by said portable radio communication device from the server, generating data based on monitoring downloading of said content, and computing the remuneration data based on the generated data, the content enabler determining payment data for said content provider based on said remuneration data (column 7, lines 38-46).

- «Claims 17 and 20»

A method according to claim 15, wherein the electronic content comprises original games content and the adaptation data comprises supplementary software for modifying the original games content (column 1, lines 35-43 and column 15, lines 15-20).

- «Claim 32»

An apparatus according to claim 22, wherein the computing means computes remuneration data only if the generated data comprises an indication that the adaptation data has been successfully applied to the electronic content (Srinivasan, column 6, lines 27-36).

- «Claim 33»

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising:

providing electronic content for storage on a memory of said portable radio communication device (column 5, lines 1-16; column 7, lines 12-18; and column 8, lines 8-18 and 31-48);

providing adaptation data on a memory of said server (column 15, lines 3-26);

allowing access to said adaptation data on said server for downloading from said memory of said server to said portable radio communication device (column 15, lines 3-26);

downloading said adaptation data from said memory of said server to said portable radio communication device (column 15, lines 3-26);

applying said adaptation data to said electronic content so as to modify said electronic content to provide adapted electronic content (column 15, lines 20-26);

generating data based on the output data of said monitoring downloading of said adaptation data (column 7, lines 38-44); and

computing remuneration data including monitoring the volume of downloads that the server is performing and computing the payment to be made to a content provider on the basis of the level of successful downloads from the server (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36).

- «Claim 34»

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising;

providing electronic content for storage on a memory of said portable radio communication device (column 5, lines 1-16; column 7, lines 12-18; and column 8, lines 8-18 and 31-48);

providing adaptation data on a memory of said server (column 15, lines 3-26);

allowing access to said adaptation data on said server for downloading from said memory of said server to said portable radio communication device (column 15, lines 3-26);

downloading said adaptation data from said memory of said server to said portable radio communication device (column 15, lines 3-26);

applying said adaptation data to said electronic content so as to modify said electronic content to provide adapted electronic content (column 15, lines 20-26);

generating data based on the output data of said monitoring downloading of said adaptation data (column 7, lines 38-44); and

receiving a signal that the download of adaptation data has been successfully received; and registering receipt of said signal in a counter (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36).

- «Claim 35»

An apparatus comprising:

a memory storing adaptation data , and a download controller, said download controller configured to communicate with an operator server and to respond to a request from an operator server for adaptation data by accessing said memory and transmitting adaptation data to an operator server [column 8 «lines 12-48» | column 14 «lines 42-43» where : Peng's remote server reads on the claimed apparatus and Peng's gateway reads on the claimed operator server that makes requests to the remote server] , said apparatus configured to compute remuneration data on the basis of the level of successful downloads of adaptation data [column 7, lines 44-46 and Srinivasan, column 6, lines 27-36].

- «Claim 36»

An apparatus where said server having an account register [column 7 «lines 27-29»].

- «Claim 37»

An apparatus where said server having a counter to monitor the level of downloads that the server is performing [column 6 «lines 42-65» where the gateway monitors the last

point of failure of the previous download to enable the mobile device to continue downloading without starting over].

- «Claim 38»

A method comprising:

in a server comprising a download controller and a memory storing adaptation data, receiving a request from an operator server for adaptation data [column 8 «lines 12-48» | column 14 «lines 42-43»];

in response to said request, accessing said adaptation data and transmitting said adaptation to an operator server [column 8 «lines 12-48» | column 14 «lines 42-43»];

monitoring the level of downloading that the server is performing [column 6 «lines 42-65»]; and

computing remuneration data on the basis of the level of successful downloads of adaptation from the server [column 7, lines 44-46 and Srinivasan, column 6, lines 27-36].

- «Claim 39»

A method including authenticating said request [column 7 «lines 46-53»].

- «Claim 40»

A method comprising receiving a signal from an operator server that a download of adaptation data has been successfully received [Srinivasan, column 6 «lines 37-42»].

- «Claim 41»

An apparatus comprising:

a transceiver, a memory and a controller, said memory being configured to store electronic content, said controller being configurable to cause said transceiver to transmit a request for adaptation data from a server [Figure 3 | column 14 «lines 42-43»: Peng's gateway reads on claimed apparatus], the request comprising an identifier of electronic content stored in said memory and security data [column 2 «line 64» to column 3 «line 8»], said transceiver being configured to receive adaptation data [column 14 «lines 44-45», said controller being configured to modify electronic content stored in said memory by applying to the electronic content the received adaptation data to provide adapted data which is stored in said memory [column 15 «lines 20-26»], said transceiver being configured to transmit an acceptance signal in response to said storing of said adaptation data [Srinivasan, column 6 «lines 27-32»].

- «Claim 42»

An apparatus according to claim 41, said electronic content comprising original games content and said adaptation data comprising supplementary software for modifying said original games content [column 1 «lines 35-43» | column 15 «lines 15-20»].

- «Claim 43»

A method comprising:

downloading adaptation data from the memory of a server to an apparatus comprising a transceiver, a memory and a controller, said memory including electronic content [Figure 3 | column 14 «lines 42-43»];

applying the adaptation data to set electronic content so as to modify the electronic content to provide adapted electronic content [column 15 «lines 15-20»]; and

generating data based on the applying of the adaptation data to the electronic content [column 7 «lines 38-44»].

- «Claim 44»

A method according to claim 43, said electronic content comprising original games content and said adaptation data comprising supplementary software for modifying said original games content [column 1 «lines 35-43» | column 15 «lines 15-20»].

- «Claim 45»

An apparatus comprising:

a memory configured to store adaptation data [Figure 3];

a gateway configured to at least selectively allow access to the adaptation data stored on the apparatus for downloading from the memory of the apparatus to a portable radio communication device [Figures 2a, 2b, 2c | Figure 3];

a download controller configured to permit the downloading the adaptation data from the memory of the apparatus to the portable radio communication device [column 7 «lines 46-53» : permitting the download only upon checking the ID of the user of the mobile device]; and

an account register system configured to monitor the volume of downloads from the apparatus [column 7 «lines 38-53»] and to compute remuneration data related to the

adaptation data and based on generated data from the portable radio communication device if the generated data includes an indication that the adaptation data has been successfully applied to the electronic content [column 7, lines 44-46 and Srinivasan, column 6, lines 27-36].

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC

/Bunjob Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152

Application Number**Application/Control No.**

09/893,547

**Applicant(s)/Patent under
Reexamination**

SHARP ET AL.

Examiner

DOHM CHANKONG

Art Unit

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